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REMARKS

In the final Office Action mailed October 7, 2003, the Examiner indicated that claims 4, 5, 14, 15, 23, 24, and 26 recite allowable subject matter and would be allowed if rewritten in independent form. Applicant thanks the Examiner for this indication of allowable subject matter.

Also in the Office Action, the Examiner rejected claims 16 and 25 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,694,322 to Westerlage et al.; rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Westerlage et al. in view of U.S. Patent No. 6,028,537 to Suman et al.; rejected claims 6, 7, 9, 11, 12, and 17-22 under 35 U.S.C. 103(a) as being unpatentable over Westerlage et al. in view of U.S. Patent No. 4,875,167 to Price et al.; rejected claims 1 and 2 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,297,781 to Turnbull et al. in view of U.S. Patent No. 5,278,547 to Suman et al.; rejected claim 3 under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al. in view of Suman et al. '547 and U.S. Patent No. 5,497,323 to McCall et al.; rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over Westerlage et al. in view of Price et al. and U.S. Patent No. 6,301,533 to Markow; and rejected claim 13 under 35 U.S.C. 103(a) as being unpatentable over Westerlage et al. in view of Price et al. and McCall et al. Applicant respectfully traverses these rejections for the reasons stated below.

By this Amendment, Applicant has cancelled claim 8 without prejudice. Applicant submits that no new matter has been introduced by this Amendment and that this Amendment does not raise any new issues.

Applicant respectfully traverses the rejection of claims 16 and 25 under 35 U.S.C. 102(b) as being anticipated by Westerlage et al.

With respect to independent claim 25, the Examiner argues that Westerlage et al. discloses the transmitter being a transceiver for receiving and interrogation signal and for transmitting vehicle mileage in response to the interrogation signal. However, Westerlage et al. neither discloses nor suggests a transceiver that transmits in response to an interrogation

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signal. The transceiver in Westerlage et al. transmits "based on some configurable condition, such as a predetermined reporting interval, a full memory buffer, a store and forward routine, or a minimum signal strength received from communications link 40."

In the final Office Action at page 14, lines 8-16, the Examiner quotes column 3, lines 39-50 of Westerlage et al., which merely states that mobile unit 50 includes a mobile positioning (GPS) receiver 80 operable to receive positioning information in the form of information streams 54 from a plurality of satellites 52 of positioning system 50. The Examiner then states "In addition, it is well known in the art that satellites at spaced orbital locations above the earth, for receiving and retransmitting the reply signal transmitted by the transceiver and a ground station for transmitting the interrogation signal and for receiving and processing the retransmitted reply signals from the satellites; therefore, based on Fig. 9 shown below, Westerlage et al. do disclose the transmitter being a transceiver for receiving an interrogation signal and for transmitting vehicle mileage in response to the interrogation signal."

Applicant does not understand the above quoted statement. The specific manner by which signals are uplinked to the GPS satellites is irrelevant. The GPS receiver 80 in the mobile unit 50 of Westerlage et al. merely receives signals from the satellites 52. When and how such signals from satellites 52 are received by GPS receiver 80 does not effect when and how mobile unit 50 transmits signals to receiver site 44. Instead, "mobile unit 22 initiates transmission of information to dispatch 30 or host 35 based on some configurable condition, such as a predetermined reporting interval, a full memory buffer, a store and forward routine, or a minimum signal strength received from communications link 40." (See column 4, lines 60-64 of Westerlage et al.) Thus, the mobile unit in Westerlage et al. does not initiate transmission of signals to the host in response to the signals from satellites 52 in the first place. None of the aforementioned triggers that cause initiation of transmission, however, could reasonably be construed as an interrogation signal.

For the reasons stated above, Applicant submits that Westerlage et al. fails to teach or suggest each and every feature of independent claim 25 and, thus, claims 25 and claim 16, which depends from claim 25, are allowable over the teachings of Westerlage et al.

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Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. 103(a) as being unpatentable over Westerlage et al. in view of Suman et al. '537. Nevertheless, Applicant has cancelled claim 8 without prejudice to expedite the prosecution of this application.

Applicant respectfully traverses the rejection of claims 1 and 2 under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al. in view of Suman et al.

The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must* both be found *in the prior art*, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP §2143.01 provides further guidance as to what is necessary in showing that there was motivation known in the prior art to modify a reference teaching. Specifically, MPEP §2143.01 states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless *the prior art* also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made,' because the references relied upon teach all aspects of the claimed invention were individually known in the prior art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

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In applying the above standards to the facts in this case, Applicant notes that the prior art does not suggest the desirability of the combined teachings of Turnbull et al. and Suman et al. Specifically, there is no suggestion in either of these references of the desirability of modifying the system disclosed in Turnbull et al. such that the odometer 154 (which the Examiner contends to correspond to the claimed "mileage accumulator") to accumulate vehicle mileage ... *in response* to a signal received by receiver 136 from a remote transmitter. The odometer in Turnbull et al. always accumulates mileage during vehicle travel and would have to be modified to be responsive to a signal from a remote transmitter. Suman et al.'547 does not suggest the desirability of such a modification, nor does Turnbull et al.

In the Office Action, the Examiner merely states "It would have been obvious to one having ordinary skill in the art ... to modify Turnbull et al.'s system to include the signal received by the receiver from the remote transmitter, as taught by Suman et al.'547, in order that travel distance can be accumulated during vehicle travel in response to a signal received by the receiver from the remote transmitter." (See page 8, line 19 through page 9, line 2).

Nothing in the prior art, however, suggests that it would have been desirable to accumulate travel distance in response to a signal from a remote transmitter. It is apparent that the Examiner simply reproduced the language of claim 1 as the requisite motivation. However, such motivation may not come from Applicant's disclosure but must be found in the prior art.

Applicant does not dispute that it may have been obvious to modify the Turnbull et al. system so that the receiver may receive a signal from a key fob 20, such as that disclosed in Suman et al.'547. However, such a modification by itself would not result in the claimed invention. Nothing in Suman et al.'547 suggests the modification to the odometer 154 of Turnbull et al. that would be needed to render it responsive to signals received from key fob 20 of Suman et al.

Not only do the references not suggest the desirability of modifying odometer 154, but one skilled in the art would not have found such a modification to be desirable since it would likely be illegal to so modify an odometer. By law, odometers must accurately measure the travel distance accumulated over the life of the vehicle. If an odometer were modified to be

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responsive to signals from a remote transmitter, the vehicle owner could effectively "roll back" the odometer by disabling it using (or not using) a remote transmitter.

The Examiner argues that Suman et al. '547 teaches a control module coupled to the vehicle's electrical system for providing predetermined control functions, which can be varied according to the positions selected by the switches and the driver as determined by the switch or the received code from a remote keyless entry transmitter which includes three push-button switches. However, nowhere does Suman et al. '547 disclose a function of the control module being to direct the system to accumulate mileage in response to a signal from the remote transmitter. Suman et al. '547 states that the functions of the program switches are to determine how the doors of the vehicle are unlocked (column 4, line 22 through column 4, line 28). It is not disclosed or suggested by Suman et al. '547 that the switches be used to direct the system to accumulate mileage.

On page 11, lines 14-21 of the Office Action, the Examiner states that Suman et al. '547 teaches a control module and a remote keyless entry having three push-button switches with a first switch employed for unlocking the doors, a second switch for locking the doors, and a third switch for actuating the trunk release "in order that travel distance can be accumulated during vehicle travel in response to a signal received by the receiver from the remote transmitter." Nowhere, however, does Suman et al. '547 suggest the above-quoted objective.

For the reasons stated above, Applicant submits that neither Turnbull et al. nor Suman et al. '547 et al., whether considered separately or in combination, teaches or suggests each and every feature of independent claim 1 and, thus, independent claim 1, as well as claim 2, which depends therefrom, are allowable over the combined teachings of Turnbull et al. in view of Suman et al. '547.

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over Turnbull et al. in view of Suman et al. '547 and McCall et al.

Claim 3 is allowable for at least the reasons stated above with respect to claims 1 and 2 from which claim 3 depends. McCall et al. fails to teach or suggest the deficiencies in the combined teachings of Turnbull et al. and Suman et al. and, thus, the combination of the three

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references does not teach or suggest each and every feature of claims 1-3. Accordingly, claim 3 is allowable over these references.

Applicant respectfully traverses the rejection of claims 6, 7, 9, 11, and 17-22 under 35 U.S.C. 103(a) as being unpatentable over Westerlage et al. in view of Price et al.

Independent claim 6 recites a vehicle mileage tracking system comprising at least "a tripmeter mounted in a vehicle for tracking travel distance of the vehicle ... wherein said tripmeter further stores an indicator in association with each trip segment whether the trip segment was a business trip or a personal trip."

As the Examiner correctly admits on page 3, third full paragraph, Westerlage et al. does not disclose storing an indicator in association with each trip segment whether the trip segment was a business trip or a personal trip. The Examiner then contends that Price et al. discloses storing an indicator in association with each trip segment whether the trip segment was a business trip or a personal trip. For the reasons stated below, however, Applicant respectfully submits that Price et al. does not disclose storing any such indicator.

The device in Price et al. includes a START button 44, which is pressed to start tallying mileage for a business trip. An EOT (end of trip) button is provided, which is pressed to stop tallying mileage for a business trip. The Price et al. device does not separately track mileage for personal trips. Instead, it only stores mileage for business trips when the START button has been actuated. Thus, Price et al. does not disclose storing an indicator in association with each trip segment whether the trip segment was a business trip or a personal trip, nor would there be any reason to do so given that Price et al. only stores business trip mileage.

Independent claim 18 recites that the vehicle tripmeter further stores "an indicator in association with each trip segment whether the trip segment was a business trip or a personal trip." As stated above with respect to independent claim 6, the combined teachings of Westerlage et al. and Price et al. do not teach this feature. Accordingly, independent claim 18, as well as claims 17 and 19-22, which depend therefrom are allowable over the teachings of Westerlage et al. and Price et al. whether considered separately or in combination.

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Applicant respectfully traverses the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over Westerlage et al. in view of Price et al. and Markow.

With respect to claim 10, Markow fails to teach or suggest the deficiencies in the combined teachings of Westerlage et al. and Price et al. as applied to independent claim 6 from which claim 10 depends. Thus, claim 10 is allowable for at least those reasons stated above with respect to claim 6.

Applicant respectfully traverses the rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over Westerlage et al. in view of Price et al. and McCall et al.

With respect to claim 13, McCall et al. fails to teach or suggest the deficiencies in the combined teachings of Westerlage et al. and Price et al. as applied to independent claim 18 from which claim 13 depends. Thus, claim 13 is allowable for at least those reasons stated above with respect to claim 18.

In view of all of the foregoing, Applicant submits that the present invention as defined in the pending claims is allowable over the prior art of record. The Examiner's reconsideration and timely allowance of the claims is requested. A Notice of Allowance is therefore respectfully solicited.

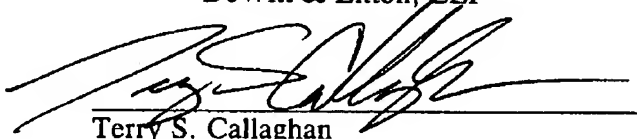
Respectfully submitted,

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